

REMARKS

Applicants respectfully request reconsideration of the present application in view of the remarks that follow.

Claims 1-4, 6 and 7 are currently being prosecuted. Claims 5, 8, 10, and 17 were previously canceled. No claims are being added.

Applicants attach a Rule 132 Declaration from Dr. Chen as evidence supporting Applicants position that one of skill in the print art would not arrive at the claimed print medium as alleged by the examiner.

I. Claim Rejections Under 35 U.S.C. § 103(a) Over Applicants' 131 Declaration

Claims 1-4, 6 and 7 are rejected as being obvious over Applicants' admission in their '131 Declaration. (Office Action, page 2) Applicants respectfully traverse the rejection.

At issue is the PTO's allegation that it would be obvious for one of ordinary skill to make the claimed combination based on Applicant's Rule 131 Declaration and pages 1 and 2 of Applicant's specification. See page 2 of the Advisory Action. Applicant respectfully traverse the obviousness rejection and state that the 131 Declaration and the referenced section of the specification do not support the PTO's position.

The inventive print medium comprises an ink-receiving layer which is present on an absorptive, coated paperbase. Claim 1 recites specific ranges for the weight of the ink-receiving layer on the coated paperbase. Additionally, the ink-receiving layer comprises at least one hydrophilic or water-soluble polymer which is present from about 60% to about 90% based on the total weight of the ink-receiving layer. The Rule 131 Declaration on file further evinces the Applicant's possession of the claimed invention. The examiner's assertions that it would be obvious for a skilled person to arrive at the inventive print medium based on the 131 Declaration is not correct.

Pursuant to Dr. Chen's statement in the attached '132 declaration, "it is well known that photo base paper is the substrate of choice to obtain high quality images using an inkjet

printer.” Furthermore, prior to the inventive paper base print medium, non-photo base paper was not used to obtain high quality images. See Chen Declaration at page 2. As explained by Dr. Chen, “it is well documented that photo base paper does not readily absorb ink due to the presence of the polyethylene layer on its surface. Because polyethylene is impermeable to ink solvents, a high coatweight of the ink receiving layer, which is capable of absorbing ink and ink solvents, is necessary to prevent smearing, bleeding, mottling, and coalescence of the inkjet print. *Id.*

Unexpectedly it was discovered that the quality of print images using the claimed print medium having an ink receiving layer and an absorptive coated paper base could be substantially enhanced to equal or exceeds the image quality of photo-based print media, if a thin coating of the ink receiving layer is placed on the paper base’s surface, to allow the ink vehicle to pass through and reach the absorptive paper base. See Chen Declaration at page 2. Indeed, as shown in the accompanying declaration, when print images on commercially available photo base print medium were compared to images on the inventive paper base print medium coated with illustrative ink-receiving compositions (A – D), the resultant image quality as measured by various indicia such as improved permanence, improved light and air fastness, and improved humid bleed and humid color shift, was significantly better for an image on the inventive print medium. Thus, as concluded by Dr. Chen in his “opinion .. the claims are not-obvious to one of ordinary skill in this art.”

Furthermore, the Supreme Court recently affirmed that to establish a *prima facie* case of obviousness, there must be “a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 82 U.S.P.Q.2d 1385 (2007). Furthermore, the court stated that there must a reason that would have prompted the claimed combination and the Applicant’s disclosure itself cannot be used to arrive at the claimed invention. See MPEP § 2144.

Here, the PTO provides no rationale why it would be obvious to combine the elements as claimed. The Office extends no rationale why one of ordinary skill in this art would coat

the paperbase with an hydrophilic polymer containing ink receiving layer in the recited weight range of 3-7 grams per square meter to arrive at the inventive print medium, especially, in view of the statements from Dr. Chen that “the photo base paper that the prior art teaches to obtain high quality images is structurally different from the inventive paper base print medium, and in particular, includes an ink receiving layer with a coatweight in the range of 25-40 grams, there is no reason to believe that one of ordinary skill in the art would expect a coated paper base with a coatweight for the claimed ink receiving layer in the 3 – 7 grams per square meter range, to result in high quality print images. Rather, one of ordinary skill in the art would expect that reducing the coat weight of the ink receiving layer would result in a deterioration of image quality. Thus, it is simply not possible to extrapolate from the photo base paper taught in the prior art to the claimed composition with its claimed paper base and claimed ink receiving layer in the 3 – 7 grams per square meter range, in the context of the claim as a whole.” See Chen Declaration at page 5.

The foregoing remarks compel the conclusion that the Examiner’s statements in support of obviousness, in fact, appear to be based on impermissible hindsight. Thus, the rejection based on the ’131 Declaration is improper and Applicant respectfully requests the reconsideration and withdrawal of the rejection.

The above response constitutes a response to the Office Actions mailed December 19, 2008 and May 7, 2009.

CONCLUSION

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 C.F.R. § 1.25. Additionally, charge any fees to Deposit Account 08-2025 under 37 C.F.R. § 1.16 through § 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

Respectfully submitted,

Date 8/18/09

By 

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